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In re Application of
Tomowaki Takahashi
Application No. 10/734,133
Filed: December 15, 2003
Attorney Docket No. 1539.1004REC

OFFICE OF PETITIONS

DECISION ON
PETITION

This is a decision on the request for reconsideration under 37 CFR 1.182, filed by facsimile transmission on June 10, 2004

Application papers in the above-identified application were filed on December 15, 2003. However, on April 7, 2004, the Office of Initial Patent Examination mailed a "Notice of Incomplete Nonprovisional Application," notifying applicant that the application had not been accorded a filing date because a complete specification as prescribed by 35 U.S.C. 112 was missing and that the application was deposited without drawings.

A petition under 37 CFR 1.182 was filed April 16, 2004 and dismissed in a decision mailed June 7, 2004. That petition sought to have December 15, 2003 accorded as the filing date of the application.

Petitioner's argument in the April 16 2004 petition, that the instant application incorporated by reference the prior application, 09/766,486, filed January 19, 2001 (issued February 24, 2004 as RE38438), was well taken. The application transmittal cover sheet indicated that the above identified application was a continuing application of prior filed application no. 09/766,486 and was incorporated by reference in its entirety. MPEP 201.06 (c) states that:

... an applicant may incorporate by reference the prior application by including, in the application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuing application to include any subject matter in such prior application(s), without the need for a petition. (emphasis supplied)

Based on petitioners' representations it appears that the specification and drawings

were present in the Office on December 15, 2003, albeit in the file of another application, *i.e.*, Application No. 09/766,486.

As required though, copies of the complete application papers filed on December 15, 2003 had not been filed with the petition filed April 16, 2004.

The instant request includes with it copies of the complete specification as prescribed by 35 U.S.C. 112 and drawings purportedly filed with the application on December 15, 2003.

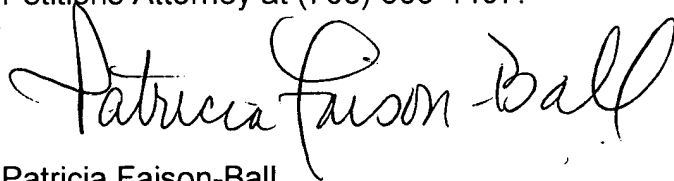
Obviously, in view of the incorporation by reference of the prior application, the complete specification as prescribed by 35 U.S.C. 112 and drawings are not new matter if it was a part of the disclosure of the prior application. New drawings may be entered by the primary examiner without petition so long as the new drawings contain no new matter. See MPEP § 608.02(a).

Accordingly, the petition is **Dismissed**.

Since the present petition was not necessitated by any error on the part of the Office, the \$130.00 petition fee will not be refunded.

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of December 15, 2003, with an indication in Office records that the complete specification as prescribed by 35 U.S.C. 112 and drawings, while not included with the application papers upon filing, was a part of the original disclosure.

Telephone inquiries regarding this decision should be directed to the undersigned Petitions Attorney at (703) 305-4497.

A handwritten signature in black ink, reading "Patricia Faison-Ball". The signature is written in a cursive, flowing style with large, connected letters.

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions